

## **REMARKS**

Claims 1-10 are now pending in the present application. Claims 1-3 have been amended and claims 5-10 have been added. Claims 1 and 7 are independent. Reconsideration of this application, as amended, is respectfully requested.

### **Domestic Priority**

The Examiner indicates that Applicants have not complied with one or more of the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. Specifically, the Examiner indicates that no reference to the prior application has been provided in the first sentence of the specification or in an application data sheet.

As the Examiner will note, the transmittal for the filing of the present application, which was submitted on December 7, 2001 includes at page 2, paragraph 5 an amendment to the specification to provide a reference to the prior filed application. In view of this, it is believed that Applicants have complied with the conditions of 35 U.S.C. § 120. The Examiner is requested to acknowledge this compliance.

### **Objection to the Specification**

The specification stands objected to since the Title of the Invention is not descriptive. As the Examiner will note, the Title has been amended to "A METHOD OF FABRICATING

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“A VEHICLE BODY FRAME FOR A MOTORCYCLE” as suggested by the Examiner. Accordingly, the specification objection has been obviated.

### **Claim Objections**

Claim 3 stands objected to for a minor informality. As the Examiner will note, claim 3 has been amended in the manner suggested by the Examiner. Accordingly, the claim objection has been obviated.

### **Rejection Under 35 U.S.C. § 112**

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

As the Examiner will note, the claims have been carefully reviewed and revised, taking into consideration the specific deficiencies pointed out by the Examiner.

In view of the above amendments and remarks, Applicants respectfully submits that claims 1-4 are definite and clear. Accordingly, reconsideration and withdrawal of the Examiner’s rejection under 35 U.S.C. § 112, second paragraph are respectfully requested.

**Rejections Under 35 U.S.C. § 103**

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants Admitted Prior Art [AAPA] in view of Sato, USPN 5,845,383. Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi et al., JP 3-136993 in view of Sato. Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over [AAPA] in view of Sato as applied to claim 1 above, and further in view of Matsuura et al., USPN 6,041,499. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi et al. in view of Sato as applied to claim 1 above, and further in view of Matsuura et al. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi et al. in view of Sato and Matsuura et al. as applied to claim 2 above and further in view of [AAPA]. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over [AAPA] in view of Sato as applied to claim 1 above, and further in view of Yamagiwa et al., USPN 5,375,677. Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi et al. in view of Sato as applied to claim 1 above, and further in view of Yamagiwa et al. These rejections are respectfully traversed.

The present invention is directed to a method of fabricating a vehicle body frame for a motorcycle, wherein a combination of steps are recited including “additionally coating only the die cast portions of the integrated article with a coating having a color generally the same as the alumite coating.” Applicants respectfully submit that the references relied on

by the Examiner fail to teach or suggest the presently claimed invention as recited in independent claims 1 and 7.

With regard to the Examiner's reliance on Applicants Admitted Prior Art, the Examiner recognizes that the [AAPA] fails to disclose coating only the die cast portions as required by the independent claims of the present invention. However, the Examiner relies on the Sato reference in order to modify the [AAPA] in order to arrive at the present invention. Applicants respectfully submit that the modification proposed by the Examiner would not have been obvious to one having ordinary skill in the art.

Referring to the Sato reference, this reference is directed to method of manufacturing baitcasting reels. Although this reference does disclose die casting an aluminum and performing alumite treatment and then painting the die cast portions, Applicants respectfully submit that this reference is quite different from the presently claimed invention for several reasons. Referring to column 8 of Sato, the painting is performed on the entire reel body. There is no indication in Sato of painting only certain portions of the reel body which is die cast, while not painting other portions of the reel body as would be necessary to disclose "coating only the die cast portions of the integrated article" as recited in the independent claims of the present invention. In view of this, Applicants submit that the teaching in Sato is insufficient to motivate one having ordinary skill in the art to specifically select to additionally coat only the die cast portions of the integrated article as in the present invention.

Applicants submit that the painting in Sato is to provide a pleasing appearance to the reel body. There is no indication in this reference that some portions of the reel body are coated with an alumite coating, while only specific portions of the reel body are additionally coated as in the present invention. Accordingly, the Sato reference fails to make up for the deficiencies of the [AAPA].

Independent claims 1 and 7 also require that the additional coating is "a coating having a color generally the same as the alumite coating." Applicants submit that for the same reasons mentioned above, the Sato reference fails to disclose this aspect of the present invention. There is no indication in Sato that the coating is carried out on specific portions of the reel body that has been treated with an alumite coating. In addition, there is no teaching in the Sato reference that the painting has a color that is generally the same as the alumite coating as in the presently claimed invention.

In the present invention, the die cast portions of the integrated article are coated with a coating having a color generally the same as the alumite coating in order to ensure that the various portions of the integrated article have the same appearance. Since the [AAPA] and Sato references fail to disclose this aspect of the present invention, Applicants respectfully submit that claim 1 is non-obvious over the combination of the [AAPA] and Sato references.

With regard to the Kobayashi et al. reference relied on by the Examiner, this reference also fails to disclose the alumite treating and additional coating of the present

invention. The Examiner relies on the Sato reference in order to make up for the deficiencies of Kobayashi et al. For the same reasons mentioned above with regard to the [AAPA], Applicants submit that the Sato reference is insufficient to modify Kobayashi et al. to arrive at the present invention. Accordingly, claim 1 is non-obvious over the combination of Kobayashi et al. and Sato.

With regard to dependent claims 2-4, Applicants respectfully submit that these claims are allowable due to their dependence upon allowable independent claim 1, as well as due to the additional recitations in these claims.

For example, dependent claim 2 requires "the step of fabricating at least one of said die cast products with molten aluminum injected into a cavity under high pressure and at least another of said die cast products by gravity die casting molten aluminum into a cavity." The Examiner relies on the Matsuura et al. reference in order to modify either of the combination of the [AAPA] and Sato references or the Kobayashi et al. and Sato references as mentioned above with regard to claim 1. However, Matsuura et al. is directed to a method of manufacturing a cylinder for a two-stroke internal combustion engine, which is non-analogous to the presently claimed invention. As mentioned in the background of the invention section of the present specification, gravity die casting is typically used in the construction of vehicle body frame parts made of aluminum, since using high pressure casting causes bubbles to be entrapped in the product and therefore an inferior part will be produced. Since Matsuura et al. is not directed to the production of vehicle body frame

members, Applicants submit that the teachings of Matsuura et al. are not relevant to the present invention. Accordingly, one having ordinary skill in the art would not be motivated to modify the combination of references relied on by the Examiner in view of the Matsuura et al. reference as asserted by the Examiner. It was Applicants that determined that high pressure casting can be used at specific gate speeds in order to arrive at an acceptable product and there is no indication in Matsuura et al. or the other references relied on by the Examiner that the necessary gate speeds to arrive at an acceptable product have been followed. Accordingly, claim 2 is non-obvious over the references relied on by the Examiner.

With regard to independent claim 4, this claim specifically recites that the gate speed for the die casting is 5-15 m/s for the molten metal. The Examiner relies on the Yamagiwa et al. reference in order to modify the combination of the [AAPA] and Sato reference and the combination of the Kobayashi et al. and Sato references as mentioned above. Applicants respectfully submit that the Yamagiwa et al. references teaches away from the present invention and therefore is insufficient to make up for the deficiencies of the combination of references relied on by the Examiner.

The Examiner relies on Yamagiwa et al. to disclose a gate speed of .5 m/s, since this reference discloses a gate speed that is higher than 50 cm/s. Referring to column 2 of the Yamagiwa et al. reference, the gate speed mentioned by the Examiner is disclosed by this reference. However, Yamagiwa also states that:

According to low pressure die casting, the speed at which [the] molten bath passes a dam can be made higher than 50 cm/sec. However, the molten bath having passed the dam is advanced into a cavity like a jet so such a phenomenon appears that a large amount of air, air bubbles, remain in a cast article. Also, solidification proceeds rapidly due to the fact that the cast article has a thin wall. Consequently, a good product having a desired strength and a desired extension characteristic cannot be obtained.

The Examiner relies on the fact that being higher than 50 cm/s overlaps with the range recited in dependent claim 4 of the present invention, i.e., 5-15 m/s. However, Applicants submit that there is no overlap in speed as suggested by the Examiner for several reasons. Yamagiwa et al. is directed to gravity casting as indicated at column 1, line 66 of this reference. Gravity casting would always be carried out at a speed much lower than the present invention, such as the 50 cm/s gate speed or less as mentioned in the Yamagiwa et al. reference. The gate speed of the present invention; however is ten times the speed mentioned in Yamagiwa et al. which is much higher than the speed ever used in any type of a gravity die casting process. In view of this, the Yamagiwa et al. reference fails to disclose the gate speed of the present invention and therefore fails to make up for the deficiencies of the references relied on by the Examiner.

In view of the above amendments and remarks, Applicants submit that claims 1-4 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the Examiner's rejections under 35 U.S.C. § 103 are respectfully requested.

**Additional Claims**

Additional claims 5-10 have been added for the Examiner's consideration. Applicants respectfully submit that claims 5 and 6 are allowable due to their dependence upon allowable independent claim 1, as well as due to the additional recitations in these claims.

With regard to additional claims 7-10, Applicants respectfully submit that these claims are allowable for the same reasons mentioned above with regard to claims 1-6.

Favorable consideration and allowance of additional claims 5-10 are respectfully requested.

**CONCLUSION**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of- the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

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In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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